

REMARKS

This Amendment and the following remarks are intended to fully respond to the Office Action dated November 23, 2004. Claims 1-28 were examined in that Office Action, and all were rejected. More specifically, claim 13 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,067,551 ("Brown et al."); claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al., in view of U.S. Patent No. 6,560,719 ("Pham et al."); claims 1, 3, 5, 9, 10, 13, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,890,177 ("Moody et al."); and claims 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al., in view of U.S. Patent No. 5,958,005 ("Thome et al.").

In this Amendment, claims 1, 5, 13 and 21 have been amended. No claims have been canceled and no new claims have been added. Therefore, claims 1-28 remain present for examination. Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

A. Claim Rejections – 35 U.S.C. § 112

Claim 13 has been amended back to original form, and therefore no longer recites those features on which the instant 35 U.S.C. §112 rejection is based. As such, this rejection is rendered moot.

B. Status of Claims 21-28

In the Summary of the Office Action, claims 21-28 are noted as being rejected, however, the basis for rejection is not addressed in the Office Action. Nevertheless, the following remarks address the patentability of claim 21 over Brown et al. and Moody et al. as these claims, like claims 1-20, are believed neither anticipated by nor rendered obvious by either of these references.

C. Claim Rejections under 35 U.S.C. §§ 102 and 103

Generally, independent claims 1, 5, 13 and 21 pertain to providing simultaneous multi-user editing of an original document. To accomplish this, the original document is checked as to whether the document is in use by a prior user in response to a request from a potentially

“subsequent” user to open the document. If the original document is in use, then a local copy of the original document is created for use by the subsequent user and a location path for the original document is stored in connection with the local copy. As such, changes made to the local copy can be merged into the original document at a later time when the document is no longer in use by the prior user.

With specific regard to each of the independent claims:

(a) Claim 1 has been amended to clarify the present invention by reciting, “storing a path of the original document in connection with the local copy” as well as the use of this path to merge the local copy with the original document (i.e., “in response to a determination that the original document is not still in use by another user, identifying a location for the original document using the stored path and merging the local copy with the original document;”).

(b) Claim 5 has been amended to recite, “storing a path of the original document in connection with the local copy” and previously already recited, in original form, “merging changes made to the local copy into the original document, the location of the original document being identified by the stored path.” (emphasis added).

(c) Claim 13 recites a document editor that “stores the document location with the local copy so that a change to the local copy can be merged with the original document at a later time.” (emphasis added).

(d) Claim 21 recites “storing a path of the original document file as part of the local document file” and further has been amended clarify the present invention by reciting the use of this stored path for later use in merging the local copy with the original document (i.e., “in response to a determination that the original document file is not still in use by another user, identifying a location for the original document using the stored path and merging the local document file with the original document file;”).

Turning now to the applicable references, Brown et al. does not teach storage of an original document path with a local copy of an original document, and thus fails to teach “each and every” limitation of the present invention, as recited in these independent claims. Therefore, Brown et al. cannot render these claims invalid under any section of 35 U.S.C. §102. See Manual of Patent Examining Procedure §2131 (August 2001) (citing *Verdegaal Bros. v. Union Oil Col. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

Instead, Brown et al. teaches a different approach to managing retrieval of edited versions for subsequent merging into an original document that involves the use of a multi-user control file (MCF). The MCF tracks all versions of a document being edited by one or more users and is described as being a “traffic cop” overseeing tracking over the many different versions of a document that may be opened for editing at the same time. See Brown et al., at Col. 2, line 52-56. This tracking functionality is administered by the MCF in order to coordinate synchronization of different versions that have been edited by the different users. See Brown et al., at Col. 2, line 56-65. As such, the MCF manages retrieval of each of the edited versions, thereby eliminating the need for storage of the original document location for future use in merging documents. Indeed, Brown et al. teaches exactly the opposite by employing the MCF to track information concerning each of the local copies rather than the original document itself. See Brown et al., at Abstract. For at least these reasons, Applicant respectfully requests reconsideration of the rejections to claims 1, 5 and 13 in view of Brown et al. as each of these claims (as well as claim 21) are believed to recite the present invention in a manner distinguishable over Brown et al.

Like Brown et al., Moody et al. fails to teach or otherwise provide a motivation or suggestion for storing an original document path with a local copy of an original document. As such, Moody et al. does not teach or suggest all limitations of any independent claim in the present application and, therefore, cannot be used to support a *prima facie* case of obviousness, the requirements of which are set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §706.02(j) (emphasis added).

Even further, Moody et al. fails to teach any method for retrieving edited versions of an original document other than prior art methods involving submission by email and floppy disk. These prior art methods each relate to a manual approach by which an editing user is required to actively submit an edited version to the author of an original document. Submission of edited versions of a document using either approach necessarily teaches away from the storage of a

location identifier (e.g., path) for the original document in connection with local copies. Modifying Moody et al. (1) to include such a feature and (2) to imply that such modification would have been ordinary to one of skill in the art is unfounded and could only be rendered from the use of impermissible hindsight gleaned from the benefits of the present invention. See, e.g., Ex parte Haymond, 41 USPQ2d 1217, 1220 (BdPatApp&Int 1996) (the examiner “may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.”). For at least these reasons, Applicant respectfully requests reconsideration of the rejections to claims 1, 5 and 13 in view of Moody et al., which is not believed to support a prima facie case of obviousness against any of these claims (as well as claim 21).

For at least the foregoing reasons, claims 1, 5, 13 and 21 are each believed allowable over Brown et al. and Moody et al. Claims 2-4, 6-12, 14-20 and 22-28 depend from claims 1, 5, 13 and 21, respectively, and therefore are believed allowable for reciting at least those limitations of the independent claims deficient from the teachings of Brown et al. and Moody et al. Applicant respectfully requests reconsideration of the outstanding rejections based on the foregoing remarks and passage of this application to allowance.

Conclusion

This Amendment fully responds to the Office Action mailed on November 23, 2004. Still, that Office Action may contain arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. For example, the obviousness rejections to claims 7, 11-12, 15 and 19-20 are not addressed due to the base rejections of independent claims 1, 5 and 13 being improper. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument to have merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns. Because this Amendment is being filed on or before February 23, 2005, no fees are believed due for submission of this Amendment. However, if this is not the case, please charge any such fees to Deposit Account No. 13-2725. Alternatively, please credit any overpayment to Deposit Account No. 13-2725.

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Respectfully submitted,

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